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HOM, SHICK C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/466,124

Applicant(s)

BRISEBOIS ET AL.

Examiner

SHICK C. HOM

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-18, 22-28, 30, 31, 36-38, 40-42, 44, 45, 47-50, 54 and 55 is/are rejected.
- 7) ☒ Claim(s) 6-8, 19-21, 29, 32-35, 39, 43, 46 and 51-53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/9/2008 have been fully considered but they are not persuasive.

In pages 19-20 of the remarks, applicant argued that while the invention is directed to data transfers between mobile stations, the prior art of Sigler is directed towards voice calls between mobile phone users is not persuasive because Sigler in col. 4 lines 26-31 recite that the network supports both voice and data operation.

In response to applicant's argument in pages 21-25 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of a very low bandwidth connection permanently maintained between the mobile station and its corresponding BTS) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments in pages 26-35 against the references individually, one cannot show nonobviousness by

attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 line 11 and likewise claims 11, 12, 22, 28, 36, 40, 44, and 45, which recite a/the "respective maintained communication links" is not clear as to with respective to what maintained links; further it lacks clear antecedent basis because no respective maintained communication links have been previously recited in the claims and therefore the limitation is not clearly understood.

Claims 2-10, 13-21, 23-27, 29-35, 37-39, 41-43, 46-55 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claims 1, 11, 12, 22, 28, 36, 40, 44, and 45, respectively.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5, 10-15, 22-24, 26-27, 28, 36-38, 40-42, 44-45, 47-48, 50, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Sigler et al. (6,477,370).

Regarding claims 1, 11, 12, 22, 26, 28, 36, 40, 44, and 45:

Sigler disclose a method for controlling data unit communications between a plurality of mobile stations in a network comprising:

enabling grouping of at least two of the plurality of mobile stations as members of a private network group; and

enabling determination of whether a first mobile station and a second mobile station are members of the private network group (the abstract recite the controller for providing communication between multiple users in a closed user group arrangement in a mobile communication system); and

enabling communication of data units from the first mobile station to the second mobile station through a maintained communication link between the first mobile station and the second mobile station that, once established is maintained throughout a session (col. 9 lines 6-63 recite the integrated mobile telephone system, typically used by public services and law enforcement agencies, behaving like a radio multi-party line whereby each party of the closed user group CUG can transmit and receive from other member of the group; and col. 31 line 66 to col. 32 line ii recite transmission being enabled only if the mobile terminal is a member of the closed user group network identifier NET ID); wherein

communications is between a first set of at least one mobile telephone station and a second set of at least one fixed

wire telephone station (Fig. 1 shows the mobile users and the PSTN, i.e. fixed wire telephone stations in claim 12).

Regarding claims 2-3, 5, 13-15, 23-24, 37-38, 41-42, 47-48, 50:

Sigler disclose wherein each of the mobile stations has a corresponding Home Location Registration (HLR) or node registration;

the enabling grouping of at least two of the plurality of mobile stations as members of a private network group comprises enabling listing of the HLRs or node registration of the at least two mobile stations within a private network group table; and

the enabling determination of whether a first mobile station and a second mobile station are members of the private network group comprises enabling determination of whether, the HLRs or node registration of the first and second mobile stations are both listed within the private network group table (col. 37 line 64 to col. 38 line 11 and col. 38 lines 45-59 recite the user validation process includes registration of the mobile terminal and whereby the mobile terminal registers to become a subscriber of the system by sending registration information which are entered into the management information system; col. 43 lines 37-41 and col. 52 line 51 recite the

serial number of the mobile terminal used by the home cellular carrier and the Home Location Register HLR; further, col. 31, lines 22- 32 recite checking whether the received NET ID matches the NET IDs assigned to the mobile terminal and if it does not match ignoring the reception).

Regarding claim 27:

Sigler disclose wherein at least one of the plurality of apparatus is a server coupled to a Local Area Network LAN (Fig. 1 shows the gateway station coupled to the PSTN reads on a server coupling to a LAN).

Regarding claims 10 and 55:

Sigler disclose an error signaler that sends an error signal to the first mobile station if the first and second mobile stations are not both members of the private network group (col. 26 lines 31-39 recite checking for errors as in claims 10 and 55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2616

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9, 16, 18, 25, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sigler et al. (6,477,370) in view of Hall et al. (6,032,051).

Sigler et al. disclose the wireless network described in paragraph 5 of this office action. Sigler et al. disclose all the subject matter of the claimed invention with the exception

of means for sending a bandwidth request signal prior to enabling communications of the data unit if the second mobile station has insufficient bandwidth capabilities to receiver the data unit on the respective maintained communication link of the second mobile station as in claims 9, 54; and wherein the means for enabling communication of the data unit from the first telephone station to the second telephone station comprises means for attaching a header to the data unit, the header comprising a data address corresponding to a second apparatus coupled to the second telephone station as a destination address; and means for outputting a resulting data unit to a data network for routing as in claims 16, 25. Although Sigler et al. did not recite wherein the second apparatus is a server coupled to a Local Area Network (LAN). The examiner takes official notice that the use of a server for coupling a LAN is well-know in the art of communications network as in claim 18.

Hall et al. from the same or similar fields of endeavor teach that it is known to provide the means for sending a bandwidth request signal prior to enabling communications of the data unit if the second mobile station has insufficient bandwidth capabilities to receiver the data unit on the respective maintained communication link of the second mobile station (see col. 1 lines 53-67 which recite checking status of

group member to determine whether or not the group member is busy reads on sending a request signal prior to enabling communications as in claims 9, 54). Hall et al. disclose wherein the means for enabling communication of the data unit from the first telephone station to the second telephone station comprises means for attaching a header to the data unit, the header comprising a data address corresponding to a second apparatus coupled to the second telephone station as a destination address; and means for outputting a resulting data unit to a data network for routing (col. 1 lines 33-37 recite the data being packet data clearly anticipate the use of a header at the data unit as in claim 16).

Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide the means for sending a bandwidth request signal prior to enabling communications of the data unit if the second mobile station has insufficient bandwidth capabilities to receiver the data unit on the respective maintained communication link of the second mobile station as taught by Hall et al. in the communications system and method of Sigler et al. The means for sending a bandwidth request signal prior to enabling communications of the data unit if the second mobile station has insufficient bandwidth capabilities to receiver the data unit on

the respective maintained communication link of the second mobile station can be implemented by connecting means for sending a bandwidth request signal of Hall et al. to the system and control of Sigler et al. The motivation for connecting the means for sending a bandwidth request signal as taught by Hall et al. in the communication system and method of Sigler et al. being that it provides more reliability for the system since sufficient bandwidth capabilities is guaranteed before enabling communication to the second station.

8. Claims 4, 17, 30, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sigler et al. (6,477,370) in view of Fraccaroli (6,549,768).

Sigler et al. disclose the wireless network described in paragraph 5 of this office action. Sigler et al. disclose all the subject matter of the claimed invention with the exception of a mobile switching center in communication with the apparatus and the radio network controller, the mobile switching center comprising means for controlling the switching operations of the wireless network within a predefined cell cluster as in claim 30; and wherein the data addresses are Internet Protocol (IP) addresses as in claims 4, 17, 49.

Fraccaroli from the same or similar fields of endeavor teach that it is known to provide the mobile switching center in communication with the apparatus and the radio network controller, the mobile switching center comprising means for controlling the switching operations of the wireless network within a predefined cell cluster (Fig. 1 shows the server 106 coupled to the network and the mobile switching center 104 for controlling the switching operations; further Fig. 1 shows the mobile switching center 104 in communication with the base station controller BSC as recited in col. 3 lines 56-63 as in claim 30). Fraccaroli disclose wherein the data addresses are Internet Protocol (IP) addresses (the abstract recite the communication network being connected to the Internet as in claims 4, 17, 49).

Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide the mobile switching center in communication With the apparatus and the radio network controller, the mobile switching center comprising means for controlling the switching operations of the wireless network within a predefined cell cluster as taught by Fraccaroli in the apparatus for group calls of Sigler et al.

The motivation for providing the mobile switching center in communication with the apparatus and the radio network controller, the mobile switching center comprising means for controlling the switching operations of the wireless network within a predefined cell cluster as taught by Fraccaroli in the apparatus for grouping calls of Sigler et al. being that it provides more efficiency of design by using the mobile switching center for controlling the switching operations of the wireless network within a predefined cell cluster.

9. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sigler et al. (6,477,370) in view of Hamalainen et al. (6,249,584).

Sigler et al. disclose the wireless network described in paragraph 3 of this office action. Sigler et al. disclose all the subject matter of the claimed invention with the exception of wherein at least one of the mobile stations comprises a personal computer with a wireless modem.

Hamalainen et al. from the same or similar fields of endeavor teach that it is known to provide at least one of the mobile stations comprising a personal computer with a wireless modem (see col. 6 lines 24-60). Thus, it would have been

obvious to the person having ordinary skill in the art at the time the invention was made to provide at least one of the mobile stations comprising a personal computer with a wireless modem as taught by Hamalainen et al. in the wireless network of Sigler et al. The at least one of the mobile stations comprising a personal computer with a wireless modem can be implemented by connecting the personal computer with a wireless modem of Hamalainen et al. in the mobile station of Sigler et al. The motivation for providing at least one of the mobile stations comprising a personal computer with a wireless modem as taught by Hamalainen et al. in the wireless network of Sigler et al. being that it provides the added feature of connecting a personal computer or data terminal into the wireless network of Sigler et al.

Allowable Subject Matter

10. Claims 6-8, 19-21, 29, 32-35, 39, 43, 46, and 51-53 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHICK C. HOM whose telephone number is (571)272-3173. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pham Chi can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chi H Pham/
Supervisory Patent
Examiner, Art Unit 2616
7/15/08

SH